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4. In an embossed card packaged production apparatus having means for producing cards from stored card information and means for inserting the cards into card carrying mailing forms, a method of verification, comprising the steps of:

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determining when a card has been incorrectly prepared; and

preventing an incorrectly prepared card from being inserted into a carrier.

5. The method of claim 4 in which the step of determining includes the step of comparing information on the card with the stored card information used to produce the card.

6. The method of claim 5 in which the step of determining includes the step of comparing the embossed information read from the card to the stored card information.

REMARKS

By the foregoing amendment, the applicant has amended the claims to correct the claim numbers and to correct a minor grammatical error. Applicant has also added three new method claims that correspond to the three apparatus claims.

Reconsideration of the rejection of the claims 1-3 under the judicially created doctrine of obviousness-type double patenting. There is absolutely no proper basis for such a rejection. The Patent and Trademark Office cannot

first claim that these claims are distinct for purposes of a restriction requirements and thus force the applicant to limit his claims and cancel the nonelected claims and then later claim that these same claims are not distinct when a divisional application is filed on them. The rejection should be withdrawn for this reason alone.

Moreover, to the extent that the double-patenting rejection is based on the assertion that the '544 patent has been assigned to Jeffery L. Hill it is based on a false premise, since it is clear on the face of the patent that the '544 patent has not been so assigned. Also, it is quite clear that the claims 1-3 of this application are patently distinct from the claims 1-3 and of U.S. Patent 5,494,544. The assertion that the only difference is terminology is illogical for all claims if they are to differ must differ by virtue of their terminology for without different terminology there cannot be different meaning. More simply, the claims of the present invention require that incorrectly prepared cards are prevented from being inserted into a carrier as opposed to prior art inserters in which incorrectly prepared card were nonetheless inserted into carriers that were then discarded but otherwise appeared the same as carriers with correctly prepared cards. There is no such limitation in any of the claims of the '544 patent. There is no requirement for embossments on the cards of claims 1 and 2 of this application as required in the claims of the '544 patent, and the determination of incorrectly prepared cards may be done in ways that does not require reading and comparing embossed characters. Moreover there is no limitation in these claims that the determination is performed by

comparing any information with information stored apart from the card and used to produce the card as specified in the claims of the '544 patent. Thus, even if the rejection were not improper because the patent office has already forced the applicant to file this divisional by previously asserting that the claims are distinct and is therefore estopped from now claiming that the claims are not distinct, there would be no proper basis for the rejection. None of the claims of the application are generic to the claims of the patent and vice versa. There is therefore no proper basis for the rejection on the basis of double patenting and withdrawal of the rejection is therefore respectfully requested.

Reconsideration of the rejection of claims 1-3 under 35USC102(b) over the Hill et al. '210 patent is respectfully requested. This is the applicant's patent and the inserter shown there was produced by the applicant, and the applicant is therefore very familiar with the content of the patent and the capabilities of the inserter that is shown. The simple fact of the matter is that the inserter in the Hill et al. patent is merely an inserter that requires the cards and the carriers to be pre-prepared by other equipment and then simply fed to the inserter. It is not an embossed card package production apparatus as specified for it has no means whatsoever "for producing cards from stored card information", as specified in claim 1. Accordingly, it also lacks the "means for comparing information on the card with the stored card information used to produce the card", as specified in claim 2, and, of course, lacks any means that "compares embossed information

read from the card to the stored card information", as specified in claim 3.

Returning to claim 1, the inserter of Hill et al. '210, has no "means for determining when a card has been incorrectly prepared". The inserter does not make cards. It simply information on the cards with which it is provided with information on the carriers with which it is provided. The cards are assumed to be correctly prepared. Cards are rejected because the information on the card does not match the information on the corresponding carrier into which it is to be inserted. The cards that are rejected are presumably correctly prepared: they are simply not the right, or matching, card for the carrier into which they are to be inserted. Thus, any means for rejecting cards so that they are not inserted into carriers does not constitute "means for preventing an incorrectly prepared card from being inserted into a carrier" as specified in claim 1. In the prior art card production systems of which the applicant is aware, incorrectly prepared cards are inserted into carriers and then the entire package is rejected which creates a card package that is incorrect but appears the same as a correctly prepared package. The confusion that this similarity can cause is avoided in the present invention in which incorrectly prepared cards are prevented from being inserted into the matching carrier.

Thus, as illustrated above, the Hill et al. '210 patent completely lacks three features of claim 1, each of which is critical to the invention: (1) Hill et al. '210 lacks any means whatsoever for producing cards (only making match-mismatch determinations), as specified in the

preamble); (2) Hill et al. lacks any means for determining whether a card has been "incorrectly prepared" (only making mismatch determinations), as specified in the second element of the claim; and (3) there are no means for preventing an "incorrectly prepared card" from being inserted into a carrier, as specified as the second element of this claim. Accordingly, there is no possibility that the Hill reference can anticipate any of the claims under 35UCS102(a). There is absolutely no support for the rejection of these claims on this basis, and withdrawal of the rejection on this basis is therefore respectfully requested. Withdrawal of the rejection is therefore respectfully requested.

The three method claims correspond directly to the apparatus claims and should be allowed for the same reasons set forth above with respect to claims 1-3.

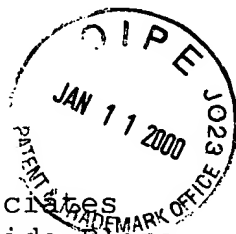
The other referenced have been reviewed but are believed to be no more relevant than the Hill et al. reference cited. Moreover, Hill et al. 5,923,015 is based on the same original parent application, serial number 08/019,865 as the present application and is therefor not prior art and cannot be properly cited against this application. Each of the other three Hill et al. patents show only inserters the same as the applied Hill et al. '210 patent, and do not show a card package production systems of the type claimed here. LaManna et al shows only a card embossing machine and has no inserter; Bobart et al. has nothing to do with credit cards, and Fujioka, likewise, has no inserter and merely shows one way of determining whether a card has been correctly prepared by comparing

information stored at different locations on the card and not by comparing the information to the original information used to produce the card. Thus, none of the cited references suggests the present invention alone or in combination.

Allowance of all claims, claims 1-6, is therefore respectfully requested.

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I hereby certify that this correspondence is being deposited with the United States Postal Service, First Class, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 this 6th day of January, 2000.

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